

YAMAP0347USD**Serial No. 09/760,950****REMARKS**

Upon entry of the present amendment, claims 1-3, 5-7, 28-33 and 40-47 are pending in the present application. Claims 8-27 have been canceled previously. Claims 34-39 have been withdrawn pursuant to a restriction requirement, and are canceled as a result, without prejudice to Applicants' right to submit these claims in a divisional application. Claims 1, 5, 6, 28, 31 and 32 are amended. Claims 1 and 28 are amended to more particularly point out and distinctly claim Applicants' invention. Support for the amendment of claims 1 and 28 may be found, for example, in Fig. 18 and in the specification, for example, as discussed in the Declaration of Uriu submitted with the Reply to Office Action filed on May 20, 2003. Claims 5, 6, 31 and 32, indicated to be allowable in the Office Action to which this Reply is responsive, are simply rewritten in independent format, so as to be allowable. New claims 40-47 have been added, respectively dependent upon each of the new independent claims. The subject matter of claims 40-43 corresponds to that of claims 2 and 29, dependent upon the newly independent claims 5, 6, 31 and 32. The subject matter of claims 44-47 corresponds to that of claims 7 and 33, dependent upon the newly independent claims 5, 6, 31 and 32.

Upon entry of the present Reply, six independent claims and 20 total claims are pending in the present application. Previously, four independent claims and 20 total claims were pending in the application (see Fee Transmittal Form filed 15 January 2001). Applicants submit herewith authorization to charge the fee for two additional independent claims ($2 \times \$200 = \400.00), as set forth at the end of this paper. No additional fee is due for the new dependent claims 40-47, since the fee for 20 total claims has already been paid.

Applicants respectfully submit that the amended and newly added claims contain no new matter and patentably distinguish over the prior art of record.

Rejection of Claims 1-7 over Tashiro et al. in view of Hirohashi.

Claims 1-3 and 28-30 stand rejected as obvious over Mizoguchi et al., U.S. Patent No. 6,593,841 in view of Takahashi, US 4,322,698. Applicants respectfully traverse the rejection of Applicants' claims.

YAMAP0347USD**Serial No. 09/760,950**

Claims 1 and 28 have been amended to recite, in addition to the other features previously included in the claims, that the conductive pattern is continuous on one surface of at least one of the magnetic insulation layers, and the conductive pattern is substantially free of discontinuities.

The device of Takahashi provides conductive lines that are not continuous on one surface of at least one of the magnetic insulation layers. Rather, Takahashi discloses a device wherein one continuous conductive pattern is formed by connecting the conductive pattern of both surfaces of the insulating layer as shown in Figs. 29 and 30 of Takahashi. Furthermore, the conductive pattern of the present invention is substantially free of discontinuities as a result of the electroforming process and as discussed in the Declaration of Uriu submitted with Applicants' Reply to Office Action filed on May 20, 2003. Takahashi provides a conductive pattern that is printed over the magnetic insulation layer (col. 4, lines 11-15), and which contains a binder. This printed conductive pattern is not substantially free of discontinuities, as discussed in the Declaration of Uriu.

In order to combine Mizoguchi et al. with Takahashi et al., as contended by the Examiner, it is necessary to omit the SiO₂ insulating layers from Mizoguchi et al. and to change the method of forming the conductive coil from the sputtering/etching process of Mizoguchi et al. to the printing method of Takahashi et al., in which the conductive coil is formed by printing with a paste of a Pd-Ag alloy. Furthermore, the thickness of the insulating layers in Mizoguchi et al. already is only 1 μm, so any thickness reduction obtained by omitting these layers will be very small.

Applicants respectfully submit that the Examiner's contended motivation for making the contended combination fails to provide any such motivation. First, in order to make the contended combination, extensive modifications would have to be made to the two reference teachings, and there is neither disclosure nor suggestion that we are aware of or, more importantly, that the examiner has cited. Furthermore, it is not clear how the Examiner's contended motivation could be obtained from either reference in support of this particular combination.

YAMAP0347USD**Serial No. 09/760,950**

Applicants respectfully submit that the Examiner's contended motivation for making the combination of Mizoguchi et al. and Takahashi et al., is legally insufficient. The statement of the contended motivation is very conclusory and includes no real analysis of reasons why a person of ordinary skill in the art would make the contended selection of elements from each reference, modify them as necessary and finally combine them as claimed, in the absence of hindsight. Applicants respectfully submit that there is simply no motivation apparent in either reference to make the wholesale modifications necessary to make the contended combination of references. In addition, Applicants respectfully submit that the two methods do not lend themselves to combination, and that the Examiner has failed to provide any more than a conclusory allegation that they could be combined. Applicants respectfully submit that the claimed invention simply could not and would not be obtained from the contended combination.

Therefore, Applicants submit that the cited references fail to teach or suggest the features of the present invention, including in combination with the other features, that the conductive pattern is continuous on one surface of at least one of the magnetic insulation layers, and the conductive pattern is substantially free of discontinuities. Therefore, Applicants submit that the invention described in claims 1-3 and 28-30 fully patentably distinguishes over the prior art of record and are allowable. Notice to such effect is respectfully requested.

Allowable Claims 5, 6, 31 and 32

Claims 5, 6, 31 and 32 have been indicated as being allowable but for their dependence on rejected base claims. Accordingly, claims 5, 6, 31 and 32 have been rewritten into independent format to include all the limitations of the original base claims. Accordingly, Applicants respectfully submit that claims 5, 6, 31 and 32 are allowable. Notice to such effect is respectfully requested.

Conclusion

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejections of Applicants' claims, and allowance of the application.

YAMAP0347USD**Serial No. 09/760,950**

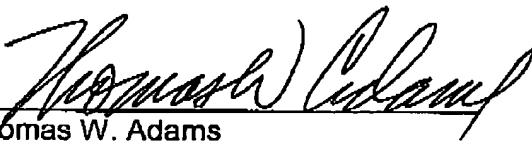
Applicants respectfully submit that the presently disclosed and claimed invention fully distinguishes over the prior art of record for the reasons set forth herein and previously.

In the event issues arise as a result of the filing of this paper, or remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application. Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed, petition therefor is hereby made and, if any additional fees are required, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, Docket No. YAMAP0347USD.

This application now contains a total of six independent claims and 16 total claims. The fee for four independent claims and 20 total claims previously has been paid. See Fee Transmittal Form filed with this application on January 15, 2001, which included four independent claims and 19 total claims. Accordingly, the fee for two additional independent claims is required at this time. The Commissioner is expressly authorized to charge the fee of \$400.00 for two additional independent claims to Deposit Account #18-0988, Docket No. YAMAP0347USD.

Respectfully submitted,
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